

REMARKS

Upon amendment, Claims 1-4, 6, 9-12, 14, and 17 are pending in this application. Claims 16, 19, 21 and 22 have been canceled without prejudice. Claims 1-4 and 14 have been amended to encompass the elected subject matter and to more clearly define the claimed subject matter. No new matter has been added by the amendments. Support for the amendments is found throughout the application and claims as originally filed.

Applicants respectfully reserve the right to pursue any non-elected, canceled or otherwise unclaimed subject matter in one or more continuation, continuation-in-part, or divisional applications.

Reconsideration and withdrawal of the objections to and the rejections of this application in view of the amendments and remarks herewith, is respectfully requested, as the application is in condition for allowance.

Note about Amendments and Arguments/ Advisory Action

Applicants note that the amendments to claims 1-4 and 14 are the same as proposed in Applicants' first Amendment and Response after Final Office Action.

In the Advisory Action, the Examiner states that "the suggested amendments in the after final rejection would cause the 112, 1st para. rejection to be withdrawn if entered." Applicants

respectfully thank the Examiner for this finding. As such, the arguments with respect to the 35 U.S.C. 112, First Paragraph rejections of these claims has been presented herein again in their entirety for the sake of convenience to the Examiner.

The Examiner goes on to state that “by rejoining the method claims, further search and consideration would be required, particularly in considering any 112, 1st rejections that might exist.” While Applicants disagree with the Examiner’s contention, and solely for the purposes of advancing the application to issue, claims 21 and 22 have been canceled without prejudice.

Applicants will address the Examiner’s double patenting rejections anew below.

Rejections under 35 U.S.C. § 112, First Paragraph

Claims 1-4, 6, 9-12, 14 and 17 are rejected under 35 U.S.C. 112, First Paragraph, as failing to comply with the enablement requirement. In particular, the Office Action alleges that “the specification, while being enabling for a compound of formula (1-A) where R¹ is hydrogen or an alkyl group, R² is a cyano group; R⁵ is a methyl group; R^{6A} is a hydrogen and R⁷ is a trifluoromethyl or halogen group, does not reasonably provided enablement for any other compounds or compositions not previously defined by the R variables.” Applicants respectfully disagree.

Without conceding the validity of the Examiner’s allegation, and solely for the purposes of advancing prosecution of the present application, Claim 1 has been amended to recite that: R¹ is hydrogen or -C₁-C₆-alkyl wherein C₁-C₆-alkyl can be further substituted with one to three

identical or different radicals selected from the group consisting of halogen, hydroxy and C₁-C₄-alkoxy, R² is a cyano group; R⁵ is a C₁-C₄-alkyl group; R^{6A} represents hydrogen, C₁-C₆-alkylcarbonyl, C₃-C₈-cycloalkylcarbonyl, wherein C₁-C₆-alkylcarbonyl can be substituted with one to three identical or different radicals selected from the group consisting of C₃-C₈-cycloalkyl, hydroxy, C₁-C₄-alkoxy, amino, mono- and di-C₁-C₄-alkylamino; and R⁷ is a represents halogen or C₁-C₆-alkyl, wherein C₁-C₆-alkyl can be further substituted with one to three identical or different radicals selected from the group consisting of halogen, hydroxy and C₁-C₄-alkoxy.

Applicants respectfully note that the Applicants and Examiner agree that the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. Nevertheless, Applicants respectfully submit that whether or not the scope of a claim is broad is irrelevant to the assessment of the enablement of the claim. Indeed, Applicants submit that the implemetation of the test is the only question at issue in the present application.

Applicants respectfully submit that the pending claims are enabled because the specification "contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented." *Id.*

While the Examiner has listed the variable definitions most commonly found in the examples, Applicants respectfully submit that one of ordinary skill in the art would readily be able to synthesize compounds in which R¹ is optionally substituted -C₁-C₆-alkyl and R⁷ is

optionally substituted C₁-C₆-alkyl based on the teachings of the specification without undue experimentation.

Applicants further submit compounds in which R⁵ is a C₁-C₄-alkyl as compounds bearing a methyl substituent would likely react in a similar manner to compounds bearing ethyl, propyl and butyl substituents and would be expected to be synthesized through very similar methods. As such, one of ordinary skill in the art would readily be able to make and use compounds bearing any lower alkyl substituent at R⁵ in light of the exemplary teaching of methyl in the examples presented in the specification.

Similarly, Applicants respectfully note that compounds in which R^{6A} represents optionally substituted C₁-C₆-alkylcarbonyl or C₃-C₈-cycloalkylcarbonyl, can be found in Examples 22-29 of the specification as originally filed. As such, one of ordinary skill in the art would readily be able to make and use compounds bearing the claimed substituents at R⁶ in light of the examples presented in the specification.

Applicants respectfully assert that one of ordinary skill in the art based on the teachings of the specification can readily make and use all of the compounds encompassed by the instant claims without undue experimentation. Applicants respectfully request that the rejections of the claims under 35 U.S.C. § 112, First Paragraph be withdrawn.

Double-Patenting Rejections

Claims 1-12, 14 and 17 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-12 and 14 of U.S. Patent Publication Application No. 2008/0021053 (“the ‘053 publication”).

The present application is the national stage of PCT/EP03/09527. The PCT filing date for this application is August 28, 2003 and the PCT 371(c) date is November 17, 2005.

The ‘053 publication is the national stage of PCT/EP05/01487. The PCT filing date for the ‘053 publication is February 15, 2005 and the PCT 371(c) date is July 20, 2007.

As such, the present application should be considered the earlier-filed of the two applications.

As the ‘053 publication has not yet issued as a patent, the double patenting rejection is a “provisional” rejection as stated above. According to M.P.E.P. §804 (I)[B](1) if "provisional" ODP rejections in two applications are the only rejections remaining in those applications, *the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer*” (emphasis added).

As the Examiner has stated that the proposed amendments would cause the 112, 1st para. rejection to be withdrawn, and Applicants have canceled method claims 21 and 22 without prejudice, Applicants believe that no other rejection remains in the present application. Since the present application is the earlier-filed application, Applicants respectfully request the ODP rejection be withdrawn and the application advanced to issuance.

CONCLUSION

In view of the amendments and remarks made herein, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are respectfully requested. Please charge any required fee or credit any overpayment to Deposit Account No. 04-1105.

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Respectfully Submitted,

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